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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,522	09/23/2004	Dinesh R. Patel	68.0456	5521

35204 7590 12/20/2006  
SCHLUMBERGER RESERVOIR COMPLETIONS  
14910 AIRLINE ROAD  
ROSHARON, TX 77583

EXAMINER
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NEUDER, WILLIAM P

ART UNIT	PAPER NUMBER
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3672

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/20/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/711,522	<b>Applicant(s)</b> PATEL ET AL.	
	<b>Examiner</b> William P. Neuder	<b>Art Unit</b> 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 November 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5-16,23-32 and 34-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15 is/are allowed.
- 6) ☒ Claim(s) 1,2,5-14,16,23-32 and 34-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6,7,36,37 and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6,7,36 and 37 call for the protection mechanism to be an encapsulation. Claims 1 and 28, from which claims 6 and 7 and 36 and 37 depend, call for the protection mechanism to be a recess. The protection mechanism cannot be both a recess and an encapsulation. Claim 46 calls for the protection mechanism to be a recessed passageway. Claim 44 from which claim 46 depends calls for the protection mechanism to be an encapsulation. The protection mechanism cannot be both an encapsulation and a recess.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1,2,5-14,16,23-32 and 34-46 are rejected under 35 U.S.C. 103(a) as being obvious over Patel et al 2003/0221829 (applied in previous office action).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and

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reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2). Patel discloses (see figures 20 plus) a lower completion 202 and an upper completion 200 for insertion into the lower completion. The upper completion 200 includes a stinger 206. A control line 226 is carried by the stinger. Control line 226 is positioned along the outside of the stinger. Figures 20 plus do not specifically disclose the means or any means for attaching the control line to the stinger. Figures 1-19 show many ways of routing control lines in completion assemblies and states in par. 83 that any routing means disclosed may be used. Figure 6 specifically discloses routing control lines in a recess formed in the exterior surface of the carrier member. It would have been considered obvious at the time of the invention to form a recess in the stinger for protecting or carrying the control line in view of the figure 1-19 embodiments that teach that it is desirable to protect the control lines in a completion assembly because they are easily damaged. As to claims 2 and 27, the upper completion comprises a packer 212 that moves with the stinger during insertion. As to claim 5, the recess (figure 6) is generally linear and oriented in an axial direction. As to claims 6 and 7, in as far as these claims are understood, figure 13 shows an encapsulation for carrying the control lines. As to claim 8, the lower completion comprises a packer 208 and control line 226 is routed through upper packer 212. As to claims 9, 38 and 39, figures 1-19 teach that the control line can

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also be mounted with a perforated base pipe and a shroud. It would have been considered obvious to mount the control line of figures 20 plus with a perforated base pipe and shroud as taught by figures 1-19 since any known way of mounting control lines in a completion could be used in a means for mounting control lines in a completion. As to claims 39 and 40, a plurality of base pipes and shrouds are connected together. As to claims 10,25 and 42, the control line can be fiber optic (see par. 95). As to claim 11, the control line can comprise a plurality of control lines (see par. 100). As to claims 12,13,26 and 43, the control line can be coupled to a distributed temperature sensor (see par. 100). As to claims 14 and 23, figures 9 and 10 disclose mounting the control lines in deviated wells and it would have been considered obvious to use the figure 20 plus embodiments in a deviated well since all embodiments are directed to control line mounting. As to claims 16,23 and 24, connection feature 216 orients the control line towards a bottom of the well, deviated or straight. As to claim 29, the lower completion includes a valve. As to claim 30, the stinger extends past the valve. As to claim 31, the control line is routed from an interior of the lower completion to an exterior of the upper completion. As to claim 32, the control line can be run on the interior (see figure 7). As to claims 34 and 35, the recess is formed along the exterior and oriented in an axial direction. As to claims 36,37 and 44, figure 13 shows that the control line can be protected by an encapsulation. As to claim 40, the base pipe sections and shrouds are rotationally aligned. As to claim 41, it would have been considered an obvious design choice to use a hinged shroud. As to claim 45, an upper

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completion is provided. As to claim 46, the control lines are mounted in recesses (figure 6).

***Allowable Subject Matter***

Claim 15 is allowed.

***Response to Arguments***

Applicant's arguments filed 11/6/06 have been fully considered but they are not persuasive. Most of applicant's arguments are to the 102 rejection that have been withdrawn. With respect to the 103 rejection, applicant argues that Patel does not disclose and provides no motivation for placement of a control line in a recess in the wall of the stinger or in an encapsulation provided on the stinger. Patel clearly discloses providing recesses and or encapsulations for protecting control lines in a completion assembly (figures 1-19). The motivation to use the teaching of protecting control lines from the figure 1-19 embodiments in the stinger embodiments of figures 20 plus is that a problem in using control lines in wells is the control lines can be become damaged and not be able to perform their desired function. Figures 1-19 clearly teach protecting the control lines to avoid the control from becoming damaged. Clearly one of ordinary skill in the art would look to protect the control lines in the completion assembly of figures 20 plus in the manner taught in figures 1-19 to help prevent damage of the control lines. With respect to claim 23, applicant argues that connection feature 216 is not an orienting mechanism to orient the control line. Connection 216 clearly functions to orient the control line when the connection is made up. The claims do not call for a

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connection means and an orienting means. There is no claim language that precludes a reading of the connection means 216 as an orienting means.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Neuder whose telephone number is 571-272-7032. The examiner can normally be reached on Tuesday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



William P Neuder  
Primary Examiner  
Art Unit 3672

W.P.N.